

**REMARKS**

After entry of this Amendment, claims 5-22, 24, and 28-36 are pending in the instant application, with claims 5, 14, and 29 in independent form. Independent claims 5, 14, and 29 have been amended to specify that the stabilized hydroalkoxysilane is provided in the absence of any epoxide. Claim 29 has also been amended to specify that the hydroalkoxysilane is mixed in the absence of any epoxide. New claims 32, 34, and 35 have been added to further claim that the carboxylate is in powdered or granular form, support for which can at least be found in paragraph [0011], lines 23-26 on page 4 of the original application as filed. New claims 33 and 36 have been added to further claim that the step of separating the carboxylate from the hydroalkoxysilane occurs in the absence of any epoxide. Claims 23 and 25-27 are presently cancelled. Claims 1-4 were previously cancelled.

The Applicants respectfully submit that the instant application as filed properly supports the amendments to independent claims 5, 14, and 29, as well as the subject matter of new claims 33 and 36. In particular, the Applicants note that the Background of the Invention section of the instant application as filed addresses previous efforts that were made to stabilize hydroalkoxysilanes. In particular, paragraph [0003] of the instant application as filed addresses attempts to stabilize hydroalkoxysilanes that involve use of epoxides (Kokai H6-220417) and use of hydrocarbons optionally having an epoxy functional group (Kokai H10-72209). However, on page 1, line 39 to page 2, line 1, it is indicated that stabilization using those compounds is undesirable because those compounds are soluble in hydroalkoxysilanes and require subsequent removal operations. In fact, because the soluble compounds (i.e., the

epoxides) are solubilized in the hydroalkoxysilanes of the prior art, filtration is impossible as the subsequent removal operation of the soluble compounds. Instead, it is well known that such a scenario would require complex removal operations such as fractional distillation. When the soluble compounds are epoxides, and when the boiling point of the epoxides is close to the boiling point of the hydroalkoxysilane, even fractional distillation cannot be used to separate the epoxides from the hydroalkoxysilanes. Further, Comparative Example 3 illustrates the use of an epoxide to stabilize hydroalkoxysilanes, but with the undesirable result of the epoxide dissolving into hydroalkoxysilane.

The Examples prepared including a carboxylate to stabilize the hydroalkoxysilane, in the absence of any epoxide, illustrate the effectiveness of the carboxylates in stabilizing the hydroalkoxysilane in the absence of any epoxide, with similar stabilization obtained as when an epoxide is used (refer to Table 2 on page 7 of the original application as filed). Thus, the Applicants respectfully submit that the language “in the absence of any epoxide” is properly supported in the application as filed. The Applicants respectfully submit that no new matter has been added through the present Amendment.

Claims 5-31 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Westmeyer et al. (United States Patent No. 6,365,696). The Applicants respectfully submit that, in view of the amendments to independent claims 5, 14, and 29, the obviousness rejections over Westmeyer et al. are overcome such that these rejections must be withdrawn.

The Applicants respectfully reiterate that when making an obviousness rejection, Office personnel must ensure that the written record includes findings of fact concerning the

state of the art and the teachings of the references applied, and it is appropriate to include explicit findings as to how a person of ordinary skill would have understood prior art teachings, or what a person of ordinary skill would have known or could have done. See MPEP 2141(II.). Again, as succinctly summarized in MPEP 2141(II.), the focus when making a determination of obviousness should be on what a person of ordinary skill in the pertinent art **would have known at the time of the invention, and on what such a person would have reasonably expected to have been able to do in view of that knowledge** (emphasis added).

The Examiner has set forth some findings as to how a person of ordinary skill would have understood prior art teachings. However, the Applicants respectfully submit that the Examiner's findings fail to properly take into account the teachings of Westmeyer et al. as a whole, and further that the amendments to independent claims 5, 14, and 29 definitively distinguish the instantly claimed invention from the teachings of Westmeyer et al. such that one of skill in the art, with knowledge of the teachings of Westmeyer et al., would **not** be taught to practice the instant invention as claimed.

To explain, the Applicants note that the carboxylates taught by Westmeyer et al. are included for purposes of stabilizing ethylenically-unsaturated epoxides, and there is no teachings whatsoever within Westmeyer et al. of stabilizing hydroalkoxysilanes with carboxylates. In particular, the composition for the hydrosilylation reaction in Westmeyer et al. comprises an ethylenically unsaturated epoxide, a silicon-hydride, a carboxylic acid salt, and a platinum catalyst, and the hydrosilylation reaction product comprises

epoxyorganosilicon compounds, the carboxylic acid salt, the platinum catalyst, and may further comprise unreacted ethylenically unsaturated epoxide. Westmeyer et al. is concerned with eliminating epoxide ring-opening polymerization when hydrosilation catalysts are employed, such as during production of epoxysilicone monomers and oligomers (see column 2, lines 10-17). In this regard, carboxylates are disclosed in Westmeyer et al. as a component that suppresses reactivity of epoxy functionality during a hydrosilation reaction of a hydrido organosilane and an ethylenically-unsaturated epoxy (see column 2, lines 38 and 39 wherein it is indicated that a carboxylic acid salt suppresses the reactivity of epoxy functionality during preparation of epoxy organosilicon compositions). Notably, the only teachings in Westmeyer et al. relative to the activity of the carboxylic acid salts are with regard to activity of the salts in suppressing the epoxide ring-opening reactions. **To be clear, there are no teachings whatsoever in Westmeyer et al. of any benefit of using carboxylic acid salts, or carboxylates, for stabilizing hydroalkoxysilanes.**

The instant amendments to independent claims 5, 14, and 29 further distinguish the instantly claimed invention from the teachings of Westmeyer et al. by specifying that epoxides are absent from the stabilized hydroalkoxysilane. By specifying that epoxides are absent from the stabilized hydroalkoxysilanes, the Applicants respectfully submit that the invention claimed in independent claims 5, 14, and 29 of the instant application is clearly novel and non-obvious over the teachings of Westmeyer et al. when proper consideration is given to **what a person of ordinary skill in the art would have reasonably expected to have been able to do in view of the knowledge obtained from Westmeyer et al.** Because

a person of ordinary skill in the art would have **only** been taught to employ carboxylic acid salts for the purpose of suppressing epoxide ring-opening reactions based upon the teachings of Westmeyer et al., the Applicants respectfully submit that one of skill in the art would never have been expected to form a stabilized hydroalkoxysilane by combining a carboxylate with hydroalkoxysilane due to the fact that there is no benefit taught by Westmeyer et al. of using carboxylates with hydroalkoxysilanes.

The Examiner has responded to previous Applicant arguments by indicating that “it is known from Westmeyer et al. that the carboxylates are stabilizing agents for the silanes”. The Applicants respectfully submit that no such teachings exist in Westmeyer et al. and, as already set forth above, **Westmeyer et al. only teaches that the carboxylates are stabilizing agents for the epoxides.**

The Examiner has also indicated that one having ordinary skill in the art, in view of the teachings of Westmeyer et al., would have known how to stabilize a hydroalkoxysilane for later use as a hydrosilation agent, at the very least. The Applicants also dispute this position taken by the Examiner due to the fact that Westmeyer et al. never discloses adding a carboxylate to a hydroalkoxysilane; however, Westmeyer et al. discloses mixing a catalyst and carboxylic acid salt in the olefin (i.e., the ethylenically unsaturated epoxide) or adding the carboxylic acid salt to the epoxysilane composition after the hydrosilation reaction is complete (see column 4, lines 57-61). There is no indication that addition of the carboxylic acid salt to the hydroalkoxysilane is suitable for purposes of the invention of Westmeyer et al. and, given the lack of any recognition in Westmeyer et al. of benefits associated with

stabilization of hydroalkoxysilanes with carboxylates, the Applicants respectfully submit that one of skill in the art would not have reasonably been taught to include the carboxylates with the hydroalkoxysilanes in the absence of any epoxides.

Finally, the Examiner has opined that one of skill in the art, recognizing that the carboxylate is an insoluble solute in the hydroalkoxysilane and desiring to separate the carboxylate from the hydroalkoxysilane so as to solely use the alkoxysilane, would have easily gleaned how to separate the carboxylate from the hydroalkoxysilane (e.g., by filtration). The Applicants also respectfully disagree with the Examiner's position in this regard. While the step of separating the carboxylate from the hydroalkoxysilane has been deleted from independent claims 5, 14, and 29, new dependent claims 33 and 36 further claim the step of separating the carboxylate from the hydroalkoxysilane in the absence of any epoxide. As set forth above, **there are no teachings whatsoever in Westmeyer et al. of any benefit of using carboxylic acid salts, or carboxylates, for stabilizing hydroalkoxysilanes, and the sole purpose for including the carboxylic acid salts according to the teachings of Westmeyer et al. are to stabilize the epoxide.** As such, the Applicants respectfully submit that the Examiner has no basis for opining that one of ordinary skill in the art would have somehow been taught to separate the carboxylic acid salt from the hydroalkoxysilane so as to solely use the hydroalkoxysilane due to the fact that to do so would completely defeat the purposes for which the carboxylic acid salts are included in the compositions of Westmeyer et al. Further, because dependent claims 33 and 36 specify that the carboxylate is separated from the hydroalkoxysilane in the absence of any

epoxide, the Applicants respectfully submit that dependent claims 33 and 36 even further distinguish the instant invention as claimed from the teachings of Westmeyer et al. on the basis that the carboxylic acid salt is only recognized as useful in Westmeyer et al. when epoxy functionality is present in the composition.

In view of the remarks set forth above, the Applicants respectfully submit that independent claims 5, 14, and 29, as amended, are both novel and non-obvious over the prior art, including Westmeyer et al., such that these claims, as well as the claims that depend therefrom, are in condition for allowance.

The appropriate fee for one new dependent claim is submitted herewith. If any additional fees are necessary to respond to the outstanding Office Action, the Commissioner is hereby authorized to charge such fees to Deposit Account No. 08-2789, in the name of Howard & Howard, or credit the account for any overpayment.

**Respectfully submitted,**

**HOWARD & HOWARD ATTORNEYS**

June 4, 2009

Date

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